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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/227,242	01.08.1999	EDWARD S. MISZCZAK	8313	8511

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MARK W. CROLL
ILLINOIS TOOL WORKS
3600 WEST LAKE AVENUE
GLENVIEW, IL 60025

EXAMINER

ELVE, MARIA ALEXANDRA

ART UNIT	PAPER NUMBER
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1725

DATE MAILED: 07/26/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Art Unit: 1725

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. Claims 9-10, 12-13, 16, 23-24 & 26-27 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Combinations of Fe-Mn Fe-Si, Fe-Ti and Fe-Mn-Si are in the claims, however it is not known if these are merely combined or compounds. Correction is required.

Claim Rejections - 35 USC § 102/103

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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4. Claims 1, 3, 5, 9-10, 12-13 & 16 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Nagarajan et al. (US Pat. 5,824,992).

Nagarajan et al. discloses a metal core weld wire in which the core composition includes iron powder usually as filler material and the core composition contains between approximately 13 to 45% of the total wire weight (abstract, col. 1, lines 15-25). The steel sheath includes about 0.005 to 0.15% carbon, and 0.1 to 1.1% Mn (col. 4, lines 25-35). Additionally, the total wire contains 0.005 to 0.150% carbon (col. 4, lines 5-14). The metal core composition contains 0.1 to 2.5% Mn, 0.2 to 10.0% Fe, 0.2 to 2.0% Si, 0.001 to 0.100% Ti and 0.3 to 12.5% Fe-Mn, 0.4 to 12.0% Fe-Si, 0.201 to 10.1% Fe-Ti, 0.5 to 14.5% Fe-Mn-Si (col. 4, lines 20-25).

Although Nagarajan et al. does not teach reduced fume generation, it does teach the same metal core weld wire composition as instant claims. If a composition is physically the same, it must have the same properties. A chemical composition and its properties are inseparable. Therefore the prior art teaches the same chemical composition, the properties of instant claims are necessarily inherent and present. See In re Spada, 15 USPQ 2d 1655, 1658.

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Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 8, 11 & 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nagarajan et al. (US Pat. 5,824,992).

Claims 8, 11 & 15 are unpatentable over Nagarajan et al., as stated in paragraph 4 above. Nagarajan et al. discloses a carbon content as low as 0.005%, although not 0.0046 or 0.0047%.

The exact amounts of each of the constituents as presently claimed are not disclosed in the prior art; however, the prior art compositions closely approximate or overlap applicant's claimed composition. It has been held that one of ordinary skill in the art at the time of the invention would have considered the claimed compositions to have been obvious because close approximation or overlapping ranges in a composition is considered to establish a prima facie case of obviousness. See In re Malagari, 182 USPQ 549, Titanium Metals v. Banner 227 USPQ 773, In re Nehrenberg 126 USPQ 383.

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Allowable Subject Matter

7. Claims 4, 6-7, 14 & 17-20 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

8. The following is a statement of reasons for the indication of allowable subject matter: the prior art does not teach the amounts of Mn, Si or Al as instant claims or the fume generation rate.

9. Claims 23-24 & 26-27 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, second paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

10. Claims 21-22 & 25 are allowed.

11. The following is an examiner's statement of reasons for allowance: the claims as supported by the specification differs from the prior art in that it does not teach a metal core composition carbon range from 0.0019 to 0.0047%.

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."


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Conclusion

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to M. Alexandra Elve whose telephone number is (703) 308-0092. The examiner can normally be reached Monday to Friday from 6:30 AM to 3:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tom Dunn, can be reached on (703) 308-3318.

Any inquiry of general nature to the status of this application or proceeding should be directed to the group receptionist whose telephone number is (703) 308-0661.


ALEXANDRA ELVE
PRIMARY EXAMINER

July 25, 2002.